

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

REMARKS/ARGUMENTS

The Office Action mailed April 15, 2005 has been received, its contents carefully noted, and the applied citation thoroughly studied. Accordingly, the foregoing revisions to the claims and the following remarks/arguments are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. Hence, the Examiner is respectfully requested to favorably receive this amendment, entering it into the subject application. Furthermore, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

At the outset, undersigned wishes to gratefully acknowledge the Examiner's perception of patentable subject matter at least as it pertains to claim 17. The Examiner's objections and rejections shall now be discussed in the same order tendered by the Examiner.

Claim Objection

On page 2 of the Office Action, the Examiner objected to Claim 19 "because it includes a reference character, 10, which is not enclosed within parentheses."

The Examiner is invited to note that undersigned has amended Claim 19 hereinabove to delete reference character 10. Therefore, it is believed that the Examiner's objection with respect to the Claim 19 has been overcome. Accordingly, withdrawal of the objection of claim 19 is respectfully requested.

Claim Rejection – 35 U.S.C. §102(b)

The Examiner had rejected claims 1 through 16 and 18 through 20 under 35 U.S.C. §102(b) as being anticipated by Prussian (U.S. Patent No.: 1,864,371).

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

Undersigned has carefully read Prussian and fails to uncover the basis by which Prussian discloses each and every element of claims 1 through 16, and claim 18 as arranged therein. Additionally, undersigned has studied Prussian while comparing the requirements of claims 19 and 20 thereto and has failed to uncover the basis by which the Examiner applies Prussian to anticipate all of the required steps contained in claims 19 and 20 respectively.

For prior art to anticipate under 35 U.S.C. § 102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference. *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q. 2d 1962, 1965 (Fed. Cir. 1989) (emphasis added).

Accordingly, “. . . the exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation.” *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

Furthermore, it is not enough, however, that the reference discloses all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “*arranged as in the claim*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added).

The above excerpts are from binding, compelling precedent within which the Examiner is constrained to operate for the basis by which rejections under 35 U.S.C. §102 are deemed proper.

Notwithstanding the foregoing, and in order to facilitate a resolution of this case, undersigned has further provided delineating language within all the independent claims to

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

further emphasize unique features of the claimed invention of this application and to provide further contrast from prior art teachings so that there can be no doubt as to the patentable distinctiveness the claimed invention enjoys over the known prior art.

Specifically, independent claim 1 has been amended hereinabove and now reads as follows: A rotatable setting device for an article of jewelry, comprising in combination: a casing having an encompassing sidewall defining a hollow casing interior, said sidewall having a bottom peripheral end defining an open bottom end and an upper peripheral end transitioning into a top with an opening therein, said top comprised of an interior rim surrounding said opening and having a bottom rim surface leading to said hollow casing interior; a rotating gem retaining means at least partially received within said hollow casing interior and including an upper portion for securely retaining a gem having a crown visible through said opening of said top of said casing; said rotating gem retaining means further including a lower portion comprised of an elongated member axially extending away from said upper portion of said gem retaining means and terminating into a tapered lower end; a plurality of radially extending protrusions disposed within said hollow casing interior and rotatably coupled to said bottom rim surface of said casing and operatively coupled to said rotating gem retaining means; and a bottom member operatively coupled across said opened bottom end of said casing and having an upper surface with a notch formed therein for rotatably receiving said tapered lower end of said elongated member therein and for rotatably biasing said plurality of radially extending protrusions with said bottom rim surface of said casing for rotatably setting the gem retaining means and gem for providing gem rotation visible through said opening in said top of said casing in response to

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

movement of said rotatable setting device. Support for the above claim amendments is found at least at page 18 paragraph 41 and at page 19 paragraph 43 of the specification.

Upon a careful reading of the patent to **Prussian** these amended teachings and requirements are clearly neither anticipated (nor rendered obvious) by the disclosure of **Prussian**. In addition, there is no teaching in any of the prior art of record to suggest providing **Prussian** with these teaching and requirements.

In stark contrast, **Prussian teaches** an interchangeable stone setting for ring tops and the like. The stone setting includes a top member 14 which has two aligned openings 18, 26 therethrough with one of the openings having notches 20 forming radial extensions of opening 18. The top member is secured to the ring by, for example, soldering. The stone setting further includes a piece of tubing cut length-wise at one end and spread apart to form integral spider arms 30, which are bent over at their outer ends to form hooks or beads 30', and has its uncut portion 34 threaded to receive a nut 36 such that a **selected stone 28 is inserted between the spider arms 30 and under hooks 30'; the stem 34 is received through the two aligned openings 18 and 26; and the nut is 36 screwed on the threaded stem 34 for drawing the arms 30 inwardly in notches 20 of the top member 14 for receiving the spider arms 30 and at the same time bringing them closer together, so that the stone is firmly and securely clamped and held against rotation.** Additionally, **Prussian teaches** that once the nut 36 is screwed up to the desired extent, it is **locked in place by turning tongues 38, provided at the lowermost portion of the threaded stem 34, outwardly into notches 40 provided for their reception in the surface of the nut 36.** Please see column 2, lines 55 through 95 and claim 13.

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

Hence, **Prussian** clearly does **not** teach the amended claim 1 limitations of “a plurality of radially extending protrusions disposed within said hollow casing interior and rotatably coupled to said bottom rim surface of said casing and operatively coupled to said rotating gem retaining means” as amended claim 1 particularly points out and distinctly claims.

Furthermore, **Prussian** clearly does **not** teach the amended claim 1 limitations of “a bottom member operatively coupled across said opened bottom end of said casing and having an upper surface with a notch formed therein for rotatably receiving said tapered lower end of said elongated member therein and for rotatably biasing said plurality of radially extending protrusions with said bottom rim surface of said casing for rotatably setting the gem retaining means and gem for providing gem rotation visible through said opening in said top of said casing in response to movement of said rotatable setting device.” as claim 1 particularly points out and distinctly claims.

In stark contrast, **Prussian** clearly teaches a **stone setting device which receives a selected stone and which is locked into place by nut 36 and tongues 38 provided at the lower most portion of the threaded stem 34 for holding the setting device and gem against rotation.**

Hence, the absence from **Prussian** of these claimed features negates anticipation as supported by the Court of Appeals for the Federal Circuit having articulated in binding, compelling precedent that “. . . [the] absence from the reference of **any** claimed element negates anticipation”. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986) (emphasis added).

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

Accordingly, **Prussian** clearly does not anticipate (nor render obvious) claim 1 particularly as now amended and, there is no teaching in any of the prior art of record to suggest providing **Prussian** with these novel features. Thus, withdrawal of the rejection of claim 1 under 35 U.S.C. §102(b) is respectfully requested.

Claims 2 through 11 all ultimately depend in series from claim 1 and thus, undersigned relies on the amendments and arguments made hereinabove with respect to claim 1 to establish that patentable distinctiveness has been made manifest with respect to claims 2 through 11. Additionally, claims 2 through 11 have been amended hereinabove to provide proper antecedence basis. Accordingly, withdrawal of the rejection of claims 2 through 11 under 35 U.S.C. §102(b) is respectfully requested.

Independent claim 12 has been amended hereinabove and now reads as follows: A rotatable setting device for an article of jewelry, comprising in combination: a rotating gem retaining means comprised of a base, a plurality of spaced apart prongs members connected to and upwardly extending away from said base for securely retaining a gem having a pavilion and a crown; said rotating gem retaining means further comprised of an elongated member connected to and downwardly extending away from said base and terminating into a tapered tip; a casing having an encompassing sidewall circumscribing said rotating gem retaining means and defining a hollow casing interior, said sidewall having an upper peripheral end transitioning into a top with an opening therein, said top comprised of an interior rim surrounding said opening and having a bottom rim surface leading to said hollow casing interior such that the crown of the gem is visible through said opening of said top of said casing and said sidewall further including a

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

bottom peripheral edge defining an opened bottom end in open communication with said hollow casing interior; a plurality of cylindrical protrusions disposed within said hollow casing interior and rotatably coupled to said bottom rim surface and operatively coupled to said plurality of spaced apart prong members; said plurality of spaced apart prong members including at least one pair of substantially diametrically opposed prong members comprised of a first prong member and a second prong member; a pair of weighted members including a first weighted member operatively coupled to said first prong member and a second weighted member operatively coupled to said second prong member for defining a pair of diametrically opposed weighted members; a bottom member operatively coupled across said opened bottom end of said casing and having an upper surface with a notch formed therein for rotatably receiving said tapered tip of said elongated member therein and for rotatably biasing said plurality of cylindrical protrusions against said bottom surface of said top of said casing for rotatably setting the rotating gem retaining means and gem for working in combination with gravity acting on said pair of diametrically opposed weighted members and movement of said rotatable setting device for providing gem rotation visible through said opening in said top of said casing. Support for the above claim amendments is found at least on page 18 paragraph 41 and page 19 paragraph 43 of the specification.

Upon a careful reading of the patent to **Prussian** these amended teachings and requirements are clearly neither anticipated (nor rendered obvious) by the disclosure of **Prussian**. In addition, there is no teaching in any of the prior art of record to suggest providing **Prussian** with these teaching and requirements.

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

For example, **Prussian** clearly does **not** teach the amended claim 12 limitations of a casing having a top having of an interior rim surrounding an opening and having a bottom rim surface and a plurality of cylindrical protrusions disposed within said hollow casing interior and rotatably coupled to said bottom rim surface and operatively coupled to a plurality of spaced apart prong members.

The **Examiner** appears to support the above by noting on page 12 of the Office Action that "As for Claim 17, the prior art, incorporating other corresponding limitations as set forth above, does not teach protrusions that are cylindrical balls."

Additionally, **Prussian** clearly does **not** teach the amended claim 12 limitations of a pair of diametrically opposed weighted members and a bottom member operatively coupled across said opened bottom end of said casing and having an upper surface with a notch formed therein for rotatably receiving said tapered tip of said elongated member therein and for rotatably biasing said plurality of cylindrical protrusions against said bottom surface of said top of said casing **for rotatably setting the rotating gem retaining means and gem** for working in combination with gravity acting on said pair of diametrically opposed weighted members and movement of said rotatable setting device **for providing gem rotation** visible through said opening in said top of said casing. Support for the above claim amendments is found at least on page 16 paragraph 36, on page 18 paragraph 41, and on page 19 paragraph 43 of the specification.

In stark contrast, and as noted hereinabove, **Prussian** clearly teaches a **stone setting device which receives a selected stone and which is locked into place by nut 36 and tongues**

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

38 provided at the lower most portion of the threaded stem 34 for holding the setting device and gem against rotation.

Accordingly, **Prussian** clearly does not anticipate (nor render obvious) claim 12 particularly as now amended and, there is no teaching in any of the prior art of record to suggest providing **Prussian** with these novel features. Thus, withdrawal of the rejection of claim 12 under 35 U.S.C. §102(b) is respectfully requested.

Claims 13 through 18 all ultimately depend in series from claim 12 and thus, undersigned relies on the amendments and arguments made hereinabove with respect to claim 12 to establish that patentable distinctiveness has been made manifest with respect to claims 13 through 18. Additionally, claims 13 through 18 have been amended hereinabove to provide proper antecedence basis. Accordingly, withdrawal of the rejection of claims 13 through 18 under 35 U.S.C. §102(b) is respectfully requested.

Independent claim 19 has been amended hereinabove and now reads as follows: A method for making a rotatable setting device for jewelry, the steps including: providing a hollow casing having an encompassing sidewall defining a hollow casing interior, the sidewall having a bottom peripheral end defining an open bottom end and an upper peripheral end transitioning into a top with an opening therein, said top comprised of an interior rim surrounding said opening and having a bottom rim surface defining a raceway leading to said hollow casing interior; providing a rotating gem retaining means comprised of a base, a plurality of spaced apart prongs members upwardly extending away from the base for securely retaining a gem having a pavilion and a crown, and an elongated member downwardly extending away from the base and

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

terminating into a tapered lower tip; inserting the rotating gem retaining means through the opening in the top of the casing and positioning at least a portion of the rotating gem retaining means within the interior of the casing such that upper portions of the plurality of prong members protrude through the opening in the top of the casing to an exterior of the casing; retaining the positioning and marking each of the plurality of spaced apart prongs members to which a protrusion is to be attached at a location directly underneath the bottom rim surface defining the raceway of the top of the casing proximate the opening in the top and then removing the rotating gem retaining means from the casing; coupling a protrusion to each marked prong at approximately each marked location; coupling at least one weighted member to at least one of the plurality of the prong members below each coupled protrusion; inserting the rotating gem retaining means through the opened bottom end and into the hollow casing interior such that the upper portions of the plurality of prong members protrude through the opening in the top of the casing to the exterior of the casing and such that each coupled protrusion is disposed within said hollow casing interior and is rotatably coupled to the bottom rim surface defining the raceway; providing a bottom member having an upper surface with a notch formed therein for rotatable receiving the tapered tip of the elongated member therein; coupling the bottom member across the opened bottom end of the casing making sure that the tapered tip of the elongated member is rotatably received within the notch of the bottom member and that each coupled protrusion is rotatably coupled to the bottom rim surface defining the raceway of the top of the casing proximate the opening for rotatable setting the gem retaining means and gem for providing gem

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

rotation visible through said opening in the top of said casing in response to movement of the rotatable setting device.

Undersigned has studied Prussian while comparing the requirements of claim 19 thereto and has failed to uncover the basis by which the Examiner applies Prussian to anticipate all of the required steps contained in claim 19. Additionally, the amended teachings and requirements of claim 19 are clearly neither anticipated (nor rendered obvious) by the disclosure of **Prussian**. Furthermore, there is no teaching in any of the prior art of record to suggest providing **Prussian** with these teaching and requirements.

For example, **Prussian** clearly does **not** teach the amended claim 19 limitations of "... **inserting the rotating gem retaining means** through the opened bottom end and into the hollow casing interior such that the upper portions of the plurality of prong members protrude through the opening in the top of the casing to the exterior of the casing and such that each coupled protrusion is disposed within said hollow casing interior and is rotatably coupled to the bottom rim surface defining the raceway; providing a bottom member having an upper surface with a notch formed therein for rotatable receiving the tapered tip of the elongated member therein; coupling the bottom member across the opened bottom end of the casing making sure that the tapered tip of the **elongated member is rotatably received within the notch of the bottom member and that each coupled protrusion is rotatably coupled to the bottom rim surface defining the raceway** of the top of the casing proximate the opening **for rotatable setting the gem retaining means and gem for providing gem rotation visible through said opening in the top of said casing in response to movement of the rotatable setting device.**"

Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

In stark contrast, and as noted hereinabove, **Prussian** clearly teaches a **stone setting device which receives a selected stone and which is locked into place by nut 36 and tongues 38 provided at the lower most portion of the threaded stem 34 for holding the setting device and gem against rotation.**

Accordingly, **Prussian** clearly does not anticipate (nor render obvious) claim 19 particularly as now amended and, there is no teaching in any of the prior art of record to suggest providing **Prussian** with these novel features. Thus, withdrawal of the rejection of claim 19 under 35 U.S.C. §102(b) is respectfully requested.

Claim 20 depends in series from claim 19 and thus, undersigned relies on the amendments and arguments made hereinabove with respect to claim 19 to establish that patentable distinctiveness has been made manifest with respect to claim 20. Additionally, claim 20 has been amended hereinabove to provide proper antecedence basis. Accordingly, withdrawal of the rejection of claim 20 under 35 U.S.C. §102(b) is respectfully requested.

Other Citations

With respect to the citations that the Examiner had cited to show the state of the art further, general agreement appears to exist with respect to their limited applicability. Hence, further commentary on these non-applied citations will not be made at this time so as to not further burden the record. Suffice to say, however, that these references when considered singly or in any conceivable combination do **not** teach nor render obvious the nexus of patentability as defined in the claims now before the Examiner.

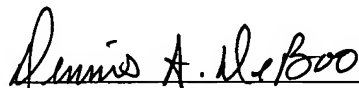
Application No. 10/763,610
Amendment Dated October 15, 2005
Reply to Office Action of April 15, 2005

Conclusion

It is undersigned sincere belief that all issues raised by the Examiner in the last Office Action have been satisfactorily addressed herein. Therefore, in view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned and suggest a convenient time when an **interview** may be conducted to expeditiously resolve same.

Dated: October 15, 2005

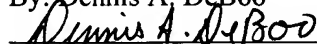
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